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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/832,828
Filing Date: April 12, 2001
Appellant(s): KAHAN ET AL.

Scott Davison
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/29/09 appealing from the Office action mailed 1/25/08.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6546002	Kim	4-2003
7089202	McNamar	8-2006
5848396	Gerace	12-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-4, 7, 8, 11, 14-17, 19-23, 26-29, 31, 34-41, 43-45, and 47-53, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim, US Patent 6546002 and further in view of McNamar et al., US Patent 7089202 hereinafter McNamar.

As in Claims 1, 14, 19, 34 and 47, Kim teaches aggregating content from a server to a mobile terminal of a subscriber (ref. 1525) comprising transmitting from the server, a provisioning profile associated with the subscriber to an outside application

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executing on a data item computer (Fig. 3, 4 with corresponding text), receiving at the server, data items from a outside application executing on a data item computer (Col 9, lines 23 et seq.) including personalized information transmitted to the subscriber where a portion of the received data items comprised personalized information transmitted to the subscriber according to the provisioning profile associated with the subscriber (Fig. 3, 4 with corresponding text) arranging at the server, the received data items for display according to a plurality of subscriber-selected presentation rules (Col. 11, line 1 et seq.), wherein each data item is associated with a generic action menu or an application specific menu corresponding to the outside application executing on the data item computer (Col. 10, line 40 et seq.) and transmitting from the server, the arranged data items to the mobile terminal of the subscriber (Col. 16, lines 12 et seq.).

While Kim teaches such a system, they fail to explicitly teach the personalized information to be pushed to the subscriber from the server as recited in the claims. McNamar teaches a networked system for data transmission of a personalized page similar that of Kim. In addition, McNamar further teaches the personalized information to be pushed to the subscriber from the server (Col. 25, lines 44 et seq.). It would have been obvious to one of ordinary skill in the art, having the teachings of Kim and McNamar before him at the time the invention was made, to modify the mobile system taught by Kim to include the personalized information to be pushed to the subscriber from the server of McNamar, in order to obtain a server initiated push of a personalized information, arranged at the server according to subscriber-selected presentation rules, to the subscriber terminal. One would have been motivated to make such a combination

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because a way to provide pre-selected information to the user when it becomes available without the user having to continuously access the site until it is available would have been obtained, as taught by McNamar (Col. 26, lines 1-7).

As in Claims 2, 15 and 20, Kim teaches updating the provisioning profile based on a command received from the mobile terminal (Fig. 7 and corresponding text)

As in Claims 3, 16, 22, 29 and 38, Kim further teaches updating the provisioning profile by transmitting this command to the control server to update a presentation rule with one of the data items with the wireless gateway and using a controller (Fig. 7 and corresponding text).

As in Claims 4, 23 and 39, Kim teaches the control server storing the updated provisioning profile in a subscriber database and further in reference to Claim 39, on the database server (Fig. 7, ref. 542-546 and corresponding text).

As in Claims 7, 26 and 43, Kim teaches the control server storing the received data items in a terminal subscriber's database (Fig. 3,4 and corresponding text) by the control server as in further reference to Claim 43.

As in Claims 8, 17, 27-28, 44-45 and 52-53, Kim teaches an application adapter translating the received data item to comply with the application interface contract if it does not already (Col. 8, line 36, et seq.).

As in Claim 11, Kim teaches the formatted data item to be transmitted to the to the receiving terminal, and furthermore by using a data communications protocol (Col. 8, line 36, et seq.).

As in Claims 21 and 37, Kim teaches the wireless gateway to receive a command from the mobile terminal (cellular requires wireless connection).

As in Claim 31, Kim teaches the wireless gateway to transmit data items to the terminal (cellular requires wireless connection).

As in Claims 35 and 48, Kim teaches an operator platform for accessing the subscriber's profile (Fig. 3, 4 and corresponding text).

As in Claims 36 and 49, Kim teaches a wireless gateway connected to the web server (it is common to one of ordinary skill in the art for a web server to be connected to a wireless gateway as suggested in Col. 6, line 22 et seq.).

As in Claims 40 and 50, Kim fails to explicitly teach a short message service center connected to the control server as recited in the claims. Within the field of the invention, it would be obvious to one of ordinary skill in the art to provide a SMS center with a cellular network. One would have been motivated to make such a combination because a communication system to cellular subscriber would have been obtained.

As in Claims 41 and 51, Kim teaches an IVR (Interactive voice response) server (Col. 6, line 46 et seq.).

Claims 10, 18, 30, 46 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Kim, US Patent, McNamar et al., US Patent 7089202 hereinafter McNamar and in further view of Gerace, US Patent 5848396.

As in Claims 10, 18 and 30, Kim and McNamar teach a mobile networking system that edits and sends data from the provider application according to ' user-updateable profiles, associating each data item with a generic action menu or an

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application specific menu and pushing the personalized information to the subscriber from the server as seen supra. While Kim and McNamar teaches such a system, they fail to explicitly teach the generating of a terminal subscriber home page according to a presentation rule associated with the data items as recited in the claims. Gerace teaches a networked system for data transmission according to user profiles similar to that of Kim and McNamar. In addition, Gerace further teaches a control server (ref 79) which generates a subscriber home page according to a user's presentation rule in the profile (Figure 4a, and corresponding text). It would have been obvious to one of ordinary skill in the art, having the teachings of Kim, McNamar and Gerace before him at the time the invention was made, to modify the networked system with push technology for providing personalized information to a subscriber terminal taught by Kim and McNamar to include the home page generation according to user defined performance rules of Gerace, in order to obtain a user-defined automatic dynamic homepage for a mobile system. One would have been motivated to make such a combination because a more personalized system for obtaining web information would have been obtained, as taught by Gerace.

As in Claims 46 and 54, Kim and McNamar teach a mobile networking system that edits and sends data from the provider application according to user-updateable profiles and associating each data item with a generic action menu or an application specific menu as seen supra. While Kim and McNamar teach such a system for obtaining data items and generating a home page according to the user's profile and rules, they fail to show the sending of a terminal subscriber home page to the web

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server as recited in the claims. Gerace teaches a networked system for data transmission according to user profiles similar to that of Kim and McNamar. In addition, Gerace further teaches transmitting the Home Page to the web server (Fig. 1 and corresponding text). It would be obvious to one of ordinary skill in the art, having the teachings of Kim, McNamar and Gerace before him at the time the invention was made, to modify the networked system with push technology for providing personalized information to a subscriber terminal taught by Kim and McNamar to include the transmitting of the Home Page to the web server of Gerace in order to obtain a pushed web transmission of a customized menu. One would have been motivated to make such a combination in order to keep a global ' copy of the generated page if the user wished to access it from other devices on the same provider or to share the user's formatted page with other users.

(10) Response to Argument

Kim teaches providing information to a mobile terminal. McNamar describes an advantage of a push-based system. In combination they teach the claim limitations.

In response to applicant's argument that there is no motivation or rationale to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.

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1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one of ordinary skill in the art would see the advantage of including the push technology of McNamar in a wide array of technologies used in a client based system (Col. 26, lines 1-7). Push technology to pass down information is especially well-known in the network communication field (both Kim and McNamar reference networking subject matter).

In response to the applicant's arguments that Kim and McNamar do not Enable the Claimed Invention, and that these references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "how the push technology works or whether it could be implemented on another type of network or system") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The mobile system of Kim is highly capable of sending and receiving messages as recited in the claims and as mapped in the rejection above and even briefly suggests a type of push technology where the MIA drives output to the user (Col. 7, lines 1-10), but fails to explicitly state the use of push technology. While McNamar is an invention targeted to a specific area of e-commerce, anyone of ordinary skill in the art could see how such technology could be used in other networking implementations. McNamar reinforces the use of networked devices and describes pushing data so that the user will receive information that the system knows they will want to receive (Col. 26).

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(11) Related Proceeding(s) Appendix

The Pre-appeal decision identified in the Related Appeals and Interferences section of the appeal brief have been provided in the appeal brief by the appellant.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Sara M Hanne/

Primary Examiner, Art Unit 2179

Conferees:

/Weilun Lo/

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